

### **REMARKS/ARGUMENTS**

The Office Action of November 23, 2004 has been carefully reviewed and this response addresses the Examiner's concerns stated in the Office Action. All objections and rejections are respectfully traversed.

Claims 1, 3-20, and 22-45 are still pending in the application. Claims 1-42 have been rejected. Claims 1, 3-20, 22-42 have been amended for consistency and to clarify the claimed invention. Claims 2 and 21 have been cancelled without prejudice. Claims 43-45 have been added.

Applicants further respectfully point out that Examiner's cited reference, Holtz, was published on May 2, 2002, almost a year after the filing date of the present application, August 15, 2001. Holtz was filed on April 18, 2001, whereas Applicants' provisional patent application upon which the present application depends was filed on August 15, 2000. Applicants respectfully reserve the right to predate or to file a petition under 37 C.F.R. § 1.131 to swear behind Holtz.

Applicants still further respectfully point out that the Examiner has not sent Applicants an initialed copy of the Information Disclosure Statement of August 19, 2002. Applicants respectfully request the initialed copy be sent to them.

#### ***Claim Rejections - 35 USC § 102(e)***

On pages 2-8, Examiner has rejected claims 1, 14-19, 23-31, and 35-42 under 35 U.S.C. § 102(e) as being anticipated by Holtz et al., U.S. Patent No. 6,760,916, issued July 6, 2004 (Holtz). Applicants respectfully point out that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (CAFC, 1987), M.P.E.P. § 2131. As provided by the remarks set forth below, clearly this is not the case with the present rejection of the claims. In summary, Holtz does not anticipate Applicants' invention because:

(1) Applicants' invention deals with receiving information from a service provider at a transmitter and forwarding that information to client devices in the context of the transmitter. The information is formatted to support the user's interaction with the service provider, for example, rebooking an airline reservation at the gate when the user's original flight is cancelled or delayed. The service provider information is targeted for client devices in need of that particular information at that particular location. Applicants, therefore, claim a method for forming and propagating an advertising signal, and receiving, decoding, and displaying the signal at the client device. Further, Applicants claim that the advertising signal can include an XML element that contains service information indicating the purpose of the advertisement, data entry information indicating purchasing options based on the purpose, and contact information about how to communicate with the service.

(2) Holtz discloses a method for sorting through various types of media available on the internet to provide custom-designed programming according to a user's preferences. In the system of Holtz, advertisers can purchase time to provide commercials along with the user's program. In the system of Holtz, advertisers pay a premium for having their commercials chosen based on, for example, a user's preferences. The centralized system of Holtz provides both a way for users to purchase media productions, and a separate way for advertisers to purchase commercials. The system of Holtz then links the advertisements that commercial entities have purchased to a media production that a user has designed, and presents the package to the user. Holtz does not specify a format for the advertisement and does not disclose any sort of data entry capability in the advertisement. Holtz does not present advertisements that are targeted to the location of the user.

Applicants have amended claim 1 to include at least the limitations of claim 2 as follows:

Claim 1: (currently amended) A method for distributing an advertisement for a service relevant to a location to a client device at the location, said method comprising the steps of:

formatting advertising information from the advertisement into XML elements, the advertising information including:

service information indicating the purpose of the advertisement;

data entry information indicating purchasing options based on the purpose; and  
contact information containing instructions for enabling the client device to  
communicate with the service;  
forming an advertising signal containing the advertising information;  
propagating the advertising signal from a transmitter to the client device within the  
location;  
receiving the advertising signal at the client device;  
decoding the advertising signal to extract the advertising information; and  
displaying the advertising information to a user of the client device.

Applicants respectfully request Examiner to reconsider the rejection of claim 1 in light of Applicants' amendments and the following arguments. To further Applicants' position of the patentability of amended claim 1 (and amended claims 3-18 that depend from amended claim 1), Applicants note the following.

With respect to amended claim 1,

(1) Examiner states that Holtz teaches a method for distributing an advertisement associated with a service to a client device, said method comprising the step of propagating said advertisement from a transmitter to said client device, said propagated advertisement forming an advertising signal containing advertising information (see col. 3, line 41-col. 4, line 18, Holtz discloses sending a transmission segment and viewing an advertisement in that segment);

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses the production and distribution of various types of media products and value added enhancements. Holtz defines what media product and value added enhancements include, and that enhancements, including advertisements, can be linked to the media product so that the user, when viewing the transmission, also views the advertisement. Applicants, on the contrary, claim the step of propagating an advertising signal from a transmitter to a client device within a location that is related to a service, where the advertisement is related to the service. Further,

Applicants claim that the advertising signal contains XML elements that include service information that indicates the purpose of the advertisement, data entry information that indicates purchasing options based on the purpose, and contact information that enables the *client device* to communicate with the service. See Applicants' specification, paragraph 108, for an example of usage of the service and data entry information. Nowhere does Holtz disclose location-dependent advertisements. Nowhere does Holtz disclose the contents of the advertisements, nor does Holtz disclose that the purpose of the advertisement and purchasing options based on the purpose are included in the service information and data entry information respectively. Nowhere does Holtz disclose the use of XML to format the advertisements.

(2) Examiner states that Holtz teaches the step of receiving said advertising signal at said client device (see col. 11, lines 57-66, Holtz discloses receiving advertising link);

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses a customized media production in which advertisements are linked to each segment of each customized program so that the user, when viewing the customized programming, also views the linked advertising. Applicants, on the contrary, claim the step of receiving the advertising signal at the client device, where the client device is located is such a place to make the service being advertised relevant to the user at that location.

(3) Examiner states that Holtz teaches the step of decoding said advertising signal to extract said advertising information (see col. 11, line 63 – col. 12, line 13, Holtz discloses accessing the world wide web to get information);

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses a customized media production in which advertisements are linked to each segment of each customized program so that the user, when viewing the customized programming, also views the linked advertising. Applicants, on the contrary, claim the step of decoding the advertising signal to extract advertising information, where the advertising information includes service information, data entry information, and contact information. Nowhere does Holtz

disclose decoding advertising information that includes service information, data entry information, and contact information.

(4) Examiner states that Holtz teaches the step of displaying said advertising information to a user of said client device (see col. 3, line 62 – col. 4, line 18, Holtz discloses displaying media production on client device).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses the production and distribution of various types of media products and value added enhancements. Holtz defines what media product and value added enhancements include, and that enhancements, including advertisements, can be linked to the media product so that the user, when viewing the transmission, also views the linked advertisement. Applicants, on the contrary, claim the step of displaying the advertising information to a user of the client device, where the advertising information includes service information, data entry information, and contact information, and where the advertisement is for a service related to a location, where the client device is at the location.

Because Applicants have combined claims 1 and 2, Examiner's 35 U.S.C. § 103 rejection of dependent claim 2 is discussed at this point. On pages 8-9 of the Office Action, with respect to dependent claim 2,

(1) Examiner states that Holtz teaches the method of claim 1 wherein said advertising information comprising an element comprising (see col. 3, line 62 – col. 4, line 18, Holtz discloses displaying media production on client device);

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses advertisements that are enhancements that are linked to each segment of each standard or customized program so that the user viewing the transmission also views the linked advertising. Nowhere does Holtz disclose advertising information including service information, data entry information, and contact information.

(2) Examiner states that Holtz teaches that said advertising information comprises an element comprising: service information enabling said user of said client device to make a

decision about said service (see col. 35, line 45 – col. 36, line 50, Holtz discloses various pricing models to choose from);

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses various pricing models for the purpose of allowing advertisers to purchase commercial time in a customized media production. Holtz discloses a separate way for users to purchase a customized media production. The customized media production can have advertisements associated with it, thereby providing two revenue streams in the system of Holtz: one from the advertisers and one from the users. Applicants, on the contrary, claim advertising information including service information indicating the purpose of the advertisement. The user and the service provider directly communicate in Applicants' system, after Applicants have been provided with an advertisement that is related to the location of the client device, tailored to the user's needs at that location. For example, the user could be provided with a rebooking form at an airline gate when faced with a cancelled or delayed flight. The user (or the client device) could fill out the form at the client device and transmit the information, either through, for example, a point of presence or a wireless link, to the service provider.

(3) Examiner states that Holtz teaches that said advertising information comprises an element comprising: data entry information informing said user about utilizing said service (see col. 35, line 64 – col. 36, line 7, Holtz discloses price information of advertisement);

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses a system that provides the prices that commercial entities pay for advertisements that accompany the personalized media production that is provided to an online client. Examiner has cited a part of the disclosure that describes the commercial revenue stream of Holtz. Applicants, on the contrary, claim advertising information that includes data entry information indicating purchasing options based on the purpose. In the system of Applicants, the service provider and the user can directly communicate through data entry information that is provided by the service provider and filled in, if necessary and desired, by the user. Nowhere does Holtz disclose advertising information that includes data entry information.

(4) Examiner states that Holtz teaches that said advertising information comprises an element comprising: contact information containing instructions for enabling said client device to communicate with said service (see col. 3, lines 46-52, Holtz discloses the information between the user and the client server).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses a system that transmits a media production over wired or wireless channels to one or more clients (such as, a personal computer, personal digital assistant, etc.). An online user in the system of Holtz can operate the client device to display and interact with the media production. The user can customize the program or request a standard program. The commercials in the media productions are chosen by the system of Holtz and, although they might be related to a list of user preferences that the user has provided when requesting the media production, are not related to the current situation of the user, for example, the location of the user. In particular and for example, if the user were standing at an airline gate of a cancelled or delayed flight, the commercial seen by the user in the system of Holtz would have been inserted when the media production was created, and therefore would not be dynamically placed into the media production depending on the user's current situation, enabling the user's client device to communicate with the service provider. Applicants, on the contrary, claim advertising information including contact information containing instructions for enabling the client device to communicate with the service. Nowhere does Holtz disclose an advertisement that includes contact information containing instructions for enabling the client device to communicate with the service.

(5) Examiner states that Holtz does not teach XML. Examiner takes Official Notice as evident by Microsoft computer Dictionary 5<sup>th</sup> edition that it would have been obvious to use XML because doing so would offer greater flexibility in organizing and processing information.

Applicants respectfully rebut the Official Notice taken that Applicants' utilization of XML to format location-dependent advertising information for broadcast would have been obvious to one having ordinary skill in the art at the time the invention was made. Applicants respectfully point out that, "[O]fficial notice unsupported by documentary evidence should only

be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961))." MPEP § 2144.03 A. Although XML is in common use, the use of XML to format interactive location-dependent advertisements is not in common enough use so that a reference to their use can be found by a simple search of the Internet. Further, Applicants' use of XML to format interactive location-dependent advertisements in combination with Applicants' other claimed features is not an obvious extension of Holtz. Finally, it is impermissible hindsight reconstruction to find the motivation to use XML to push location-dependent advertisements to a client device in the combination of Holtz and the Microsoft Dictionary 5<sup>th</sup> edition, neither of which discloses or suggests the formatting of a location-dependent advertisement.

Since Holtz and Official Notice do not anticipate and/or make obvious each and every element of Applicants' amended claim 1, either expressly or inherently, Applicants' amended claim 1 (as well as amended claims 3-18 that depend, either directly or indirectly, therefrom and that further define the invention) is not made obvious by Holtz, and a rejection under 35 U.S.C. § 102(e) is inappropriate. Applicants assert that amended claim 1 (as well as amended claims 3-18 that depend, either directly or indirectly, therefrom) is now in condition for allowance. Applicants respectfully request the withdrawal of rejections under 35 U.S.C. § 102(e) (and 35 U.S.C. 103 (a)) with regards to amended claim 1, and amended claims 3-18 which depend, either directly or indirectly, therefrom, for the reasons set forth above. Furthermore, a 35 U.S.C. § 103 rejection of these claims would be inappropriate as well. Applicants' claimed invention is not an obvious extension of the use of Holtz and Official Notice to meet Applicants' patentable limitations.

On page 3 of the Office Action, with respect to amended dependent claim 14, which depends from amended claim 1, Examiner states that Holtz teaches the method of claim 1



wherein said advertisement is propagated as an optical signal through the air (see col. 15, lines 20-35, and Fig. 3, Holtz discloses communication using optical interface).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses communications interface 324 that allows software and data to be transferred between computer system 300 and external devices. Holtz also discloses, in FIG. 3, communications interface 324 connecting communication infrastructure 306 and communications path 326. Applicants, on the contrary, claim that the advertisement of amended claim 1 is propagated as an optical signal through air. Nowhere does Holtz disclose the nature of "external devices", i.e. what is connected to communications path 326. In particular, nowhere does Holtz disclose that anything other than signals embodying software or a computer program product that implements the invention is propagated over communications interface 324.

Since Holtz does not anticipate each and every element of Applicants' dependent amended claim 14, either expressly or inherently, Applicants' dependent amended claim 14 (as well as dependent amended claims 15-17 that depend, either directly or indirectly therefrom, and that further define the invention) are not anticipated by Holtz, and a rejection under 35 U.S.C. § 102(e) is inappropriate. Applicants assert that dependent amended claim 14 (as well as dependent amended claims 15-17 that depend, either directly or indirectly therefrom) are now in condition for allowance. Applicants respectfully request the withdrawal of rejections under 35 U.S.C. § 102(e) with regards to dependent amended claim 14, and amended claims 15-17 which depend, directly or indirectly, therefrom, for the reasons set forth above. Furthermore, a 35 U.S.C. § 103 rejection of these claims would be inappropriate as well. Applicants' claimed invention is not an obvious extension of the use of Holtz to meet Applicants' patentable limitations.

To further Applicants' position of the patentability of amended claim 15 (and amended claims 16-17 that depend from amended claim 15), Applicants note the following.

On page 3 of the Office Action, with respect to dependent amended claim 15, Examiner states that Holtz teaches the method of claim 14 wherein said optical signal has a wavelength in

the range of substantially 850 nanometers to 1250 nanometers (see col. 15, lines 20-35, and Fig. 3, Holtz discloses communication using optical signal).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses the use of optical signals, but nowhere does Holtz disclose a range of wavelengths for the signals. Further, optical wireless data transmission, which is similar to wireless microwave data transmission technology, except that it uses light rather than radio waves to transmit voice and data signals, relies on wavelengths in the IR spectrum. The IR spectrum has a range of 350,000 nm to 700 nm. Applicants claim a wavelength range for the optical signal of 850 to 1250 nm.

On page 3 of the Office Action, with respect to dependent amended claim 16, Examiner states that Holtz teaches the method of claim 15 wherein said transmitter receives said advertisement over an Internet (see col. 23, lines 12-26, Holtz discloses reception of broadcast over the internet).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses that the enhanced media clients 120 can receive the radio broadcast over the Internet. Applicants, on the contrary, claim that the transmitter receives the advertisement over an Internet. The enhanced media client 120 of Holtz is equivalent to Applicants' client device. Applicants claim the step of propagating the advertising signal from a transmitter to the client device. Nowhere does Holtz disclose a transmitter that receives an advertisement over an Internet and then propagates the advertisement to a client device.

On page 3 of the Office Action, with respect to dependent amended claim 17, Examiner states that Holtz discloses the method of claim 15 wherein said transmitter receives said advertisement over a fiber optic network (see col. 14, lines 11-18, Holtz discloses sharing of resources using fiber optic transmission lines).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses a server with shared resources, some of which include communication devices that include fiber optic technology. Applicants, on the contrary, claim that the transmitter receives

the advertisement over a fiber optic network. Applicants claim the step of propagating the advertising signal from a transmitter to the client. Nowhere does Holtz disclose a transmitter that receives an advertisement over a fiber optic network and then propagates the advertisement to a client device.

Since Holtz does not anticipate each and every element of Applicants' dependent amended claim 15, either expressly or inherently, Applicants' dependent amended claim 15 (as well as dependent amended claims 16-17 that depend therefrom and that further define the invention) is not anticipated by Holtz, and a rejection under 35 U.S.C. § 102(e) is inappropriate. Applicants assert that dependent amended claim 15 (as well as dependent amended claims 16-17 that depend therefrom) is now in condition for allowance. Applicants respectfully request the withdrawal of rejections under 35 U.S.C. § 102(e) with regards to dependent amended claim 15, and dependent amended claims 16-17 which depend therefrom, for the reasons set forth above. Furthermore, a 35 U.S.C. § 103 rejection of these claims would be inappropriate as well. Applicants' claimed invention is not an obvious extension of the use of Holtz to meet Applicants' patentable limitations. Finally, amended claim 15 depends upon amended claim 14 which is not anticipated by Holtz as argued above.

Applicants have amended claim 19 to clarify the original intent of claim 19 as follows:

Claim 19: (currently amended) A method for conveying information comprising the steps of:  
preparing the information including:

- service information indicating the purpose of the information;
- data entry information indicating purchasing options based on the purpose; and
- contact information containing instructions for enabling the client device to communicate with the service;

receiving the information from a service into a transmitter having a link layer;

formatting the information for transmission to a client device operating within a context associated with the transmitter; and

conveying the information from the transmitter to the client device over a communication medium.

Applicants respectfully request Examiner to reconsider the rejection in light of Applicants' amendments and the following arguments. To further Applicants' position of the patentability of amended claim 19 (and amended claims 20 and 22-24 that depend from amended claim 19), Applicants note the following.

With respect to amended claim 19, on pages 3-4 of the Office Action,

(1) Examiner states that Holtz teaches a method for conveying an advertisement from a transmitter having a link layer, said method comprising the steps of receiving said advertisement from a service (see col. 11, lines 57-66, Holtz discloses receiving advertising link);

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses a customized media production in which advertisements are linked to each segment of each customized program so that the user, when viewing the customized programming, also views the linked advertising. Applicants, on the contrary, claim the steps of (1) preparing the information to include service information indicating the purpose of the information, data entry information indicating purchasing options based on the purpose, and contact information containing instructions for enabling the client device to communicate with the service, and (2) receiving the information from a service into a transmitter having a link layer. A link layer is executable code that manages communications at the link level between the transmitter and the client device. Nowhere does Holtz disclose that the contents of the information that is received includes service information, data entry information, and contact information. Nowhere does Holtz disclose a transmitter having a link layer. Nowhere does Holtz disclose a transmitter that receives information from a service.

(2) Examiner states that Holtz teaches the step of formatting said advertisement for transmission to a client device operating within a context associated with said transmitter (see col. 8, lines 13-22, Holtz discloses the transmission of formatted media stream);

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses an enhanced media server that transmits, to enhanced media clients, media streams formatted to support multimedia applications. Applicants, on the contrary, claim the step of formatting information for transmission to a client device operating within a context associated with the transmitter. Nowhere does Holtz disclose transmitting information to a client device operating within a context associated with a transmitter. Nowhere does Holtz disclose a transmitter that formats the information.

(3) Examiner states that Holtz teaches the step of conveying said advertisement to said client device over a communication medium (see col. 3, line 62 – col. 4, line 18, Holtz discloses displaying media production on client device).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses the production and distribution of various types of media products and value added enhancements. Holtz defines what media product and value added enhancements include, and that enhancements, including advertisements, can be linked to the media product so that the user, when viewing the transmission, also views the linked advertisement. Applicants, on the contrary, claim the step of conveying information to the client device over a communication medium.

Because Applicants have combined amended claims 19 and 21, Examiner's 35 U.S.C. § 103 rejection of dependent claim 21 is discussed at this point. On page 12 of the Office Action, with respect to dependent claim 21,

(1) Examiner states that Holtz teaches the method of claim 20 wherein said advertisement includes service information enabling a user of said client device to make a decision about said service (see col. 35, line 45 – col. 36, line 50, Holtz discloses various pricing models to choose from);

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses a sales manager that is programmed to implement a pricing model for advertisements that accompany the personalized media production of Holtz. Holtz discloses that advertisers

wishing to purchase commercial time have a choice of options. Applicants, on the contrary, claim information that includes service information indicating the purpose of the information. The user of the client device is the online user of the system of Holtz (col. 3, line 50), not the provider of a service wishing to provide information to the client device or online user.

(2) Examiner states that Holtz teaches that said advertisement includes data entry information informing said user about utilizing said service (see col. 35, line 64 – col. 36, line 7, Holtz discloses price information of advertisement);

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses a system that provides the prices that commercial entities pay for advertisements that accompany the personalized media production that is provided to an online client. Applicants, on the contrary, claim information that includes data entry information indicating purchasing options based on the purpose. Nowhere does Holtz disclose that the information provided to the user includes data entry information.

(3) Examiner states that Holtz teaches that said advertisement includes contact information containing instructions for enabling said client device to communicate with said service (see col. 3, lines 46-52, Holtz discloses the interaction between the user and the client server).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses a system that transmits a media production over wired or wireless channels to one or more clients (such as, a personal computer, personal digital assistant, etc.). An online user in the system of Holtz can operate the client to display and interact with the media production. The user can customize the program or request a standard program. Applicants, on the contrary, claim information including contact information containing instructions for enabling the client device to communicate with the service. Nowhere does Holtz disclose an advertisement that includes contact information containing instructions for enabling the *client device* to communicate with the service.

Since Holtz does not anticipate each and every element of Applicants' amended claim 19, either expressly or inherently, Applicants' amended claim 19 (as well as amended claims 20 and 22-24 that depend, either directly or indirectly, therefrom and that further define the invention) is not made obvious by Holtz, and a rejection under 35 U.S.C. § 102(e) is inappropriate. Applicants assert that amended claim 19 (as well as amended claims 20 and 22-24 that depend, either directly or indirectly, therefrom) is now in condition for allowance. Applicants respectfully request the withdrawal of rejections under 35 U.S.C. § 102(e) with regards to amended claim 19, and amended claims 20 and 22-24 that depend, either directly or indirectly, therefrom, for the reasons set forth above. Furthermore, a 35 U.S.C. § 103 rejection of these claims would be inappropriate as well. Applicants' claimed invention is not an obvious extension of the use of Holtz to meet Applicants' patentable limitations.

On page 4 of the Office Action, with respect to dependent amended claim 24, which depends from amended claim 19, Examiner states that Holtz teaches the method of claim 19 wherein said client device includes a client device physical layer and a client device link layer compatible with said link layer in said transmitter (see col. 4, lines 19-34, and Figs. 3 and 4, Holtz discloses links among network devices).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses advertisements that are linked to the enhanced multimedia and the pricing models to sell those advertisements. In Fig. 3, Holtz discloses a communications interface, a communications path, and a communications infrastructure, among other things. In Figs. 4A and 4B, Holtz discloses interactive time sheet graphical user interfaces. Applicants, on the contrary, claim a client device that includes a client device physical layer and a client device link layer that is compatible with the link layer in the transmitter. Both physical and link layers define protocols that allow the client device and the transmitter to understand the messages exchanged between them. Nowhere does Holtz disclose a client device physical layer or a client device link layer that is compatible with the link layer in the transmitter.

Since Holtz does not anticipate each and every element of Applicants' dependent amended claim 24, either expressly or inherently, Applicants' dependent amended claim 24 is not

anticipated by Holtz, and a rejection under 35 U.S.C. § 102(e) is inappropriate. Applicants assert that dependent amended claim 24 is now in condition for allowance. Applicants respectfully request the withdrawal of rejections under 35 U.S.C. § 102(e) with regards to dependent amended claim 24 for the reasons set forth above. Furthermore, a 35 U.S.C. § 103 rejection of this claims would be inappropriate as well. Applicants' claimed invention is not an obvious extension of the use of Holtz to meet Applicants' patentable limitations.

Applicants have amended independent claim 25 to clarify the invention as follows:

Claim 25: (currently amended) A method for interacting with a service provider comprising the steps of:

- receiving a broadcast message having service information from a service provider;
- creating a service object from the service information;
- activating the service object;
- receiving user data into the service object;
- sending the user data to the service provider;
- receiving service provider data required to utilize the service from the service provider;

and

- displaying the service provider data required to utilize the service.

Applicants respectfully request Examiner to reconsider the rejection of claim 25 in light of Applicants' amendments and the following arguments. To further Applicants' position of the patentability of amended claim 25 (and amended claims 26-28 and new claims 43-45 that depend, either directly or indirectly, from amended claim 25), Applicants note the following.

With respect to amended independent claim 25, on pages 4-5 of the Office Action,

(1) Examiner states that Holtz teaches a method for receiving an advertisement from a transmitter having an emitter link layer associated therewith, said method comprising the step of receiving said advertisement at a communication interface (see col. 11, lines 57-66, Holtz discloses receiving advertising link);



As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses a customized media production in which advertisements are linked to each segment of each customized program so that the user, when viewing the customized programming, also views the linked advertising. Applicants, on the contrary, claim the step of receiving the advertisement at a communication interface from a transmitter having an emitter link layer. A link layer is executable code that manages communications at the link level between the transmitter and the client device. Nowhere does Holtz disclose a transmitter having an emitter link layer. Nowhere does Holtz disclose a transmitter that receives an advertisement at a communication interface.

(2) Examiner states that Holtz teaches the step of decoding said advertisement to extract information contained therein (see col. 3, line 62 – col. 4, line 34, Holtz discloses displaying of advertisement by different criteria);

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses advertisements that are enhancements that are linked to each segment of each standard or customized program so that the user viewing the transmission also views the linked advertising. Nowhere does Holtz disclose decoding the advertisement to extract information contained therein.

(3) Examiner states that Holtz teaches the step of processing said information (see col. 9, lines 55-62, Holtz discloses the processing of the request);

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses an enhanced media server that functions as a portal to process or service requests for media produced or archived within system 100, and enforces security protocols to protect system data. Applicants, on the contrary, claim the step of processing the information extracted from the advertisement.

(4) Examiner states that Holtz teaches the step of displaying said information to a user (see col. 3, line 62 – col. 4, line 18, Holtz discloses displaying media production on client device).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses advertisements that are enhancements that are linked to each segment of each standard or customized program so that the user viewing the transmission also views the linked advertising. Nowhere does Holtz disclose displaying information extracted from the advertisement to a user.

Since Holtz does not anticipate each and every element of Applicants' amended claim 25, either expressly or inherently, Applicants' amended claim 25 (as well as amended claims 26-28 and new claims 43-45 that depend, either directly or indirectly, therefrom and that further define the invention) is not made obvious by Holtz, and a rejection under 35 U.S.C. § 102(e) is inappropriate. Applicants assert that amended claim 25 (as well as amended claims 26-28 and new claims 43-45 that depend, either directly or indirectly, therefrom) is now in condition for allowance. Applicants respectfully request the withdrawal of rejections under 35 U.S.C. § 102(e) with regards to amended claim 25, and amended claims 26-28 and new claims 43-45 which depend, either directly or indirectly, therefrom, for the reasons set forth above. Furthermore, a 35 U.S.C. § 103 rejection of these claims would be inappropriate as well. Applicants' claimed invention is not an obvious extension of the use of Holtz to meet Applicants' patentable limitations.

On page 5 of the Office Action, with respect to dependent amended claim 26, which depends from amended claim 25, Examiner states that Holtz teaches the method of claim 25 wherein said emitter link layer is compatible with a client device link layer associatively coupled to said communication interface (see col. 8, lines 13-22).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses an enhanced media server that transmits, to enhanced media clients, media streams formatted to support multimedia applications. Applicants, on the contrary, claim an emitter link layer that is compatible with a client device link layer associatively coupled to the communication interface. Nowhere does Holtz disclose an emitter link layer that is compatible with a client device link layer associatively coupled to the communication interface.

On page 5 of the Office Action, with respect to dependent amended claim 27, which depends from amended claim 25, Examiner states that Holtz teaches the method of claim 25 wherein said information is displayed using a plug-in cooperatively associated with said advertisement (see col. 4, lines 35-42, Holtz discloses displaying advertised item).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses that pricing models are based on a combination of over-the-air broadcast criteria and client-server metrics, and that these factors are combined to create varying degrees of certainty that a sponsored advertisement actually would be presented, received or viewed by the greatest quantity of users most likely to purchase the advertised item or service. Applicants, on the contrary, claim that the information extracted from the advertisement is displayed using a plug-in cooperatively associated with the advertisement. Nowhere does Holtz disclose extracting information from an advertisement, associating a plug-in with the advertisement, or displaying the advertisement using the plug-in.

On page 5 of the Office Action, with respect to dependent amended claim 28, which depends from amended claim 27, Examiner states that Holtz teaches the method of claim 27 wherein said plug-in further includes information about a preference of said user (see col. 4, lines 58 – col. 5, line 7, Holtz discloses setting up of a template based on personal preference).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses integration of media productions from various sources, and that a live media production is recorded at a local station and is indexed for easy retrieval and viewing by viewers who can either query the index and select the news segment they want to view or the user can set up a template to automatically generate a news program based on personal preference. The system of Holtz then compiles the news program, potentially with advertisements, and downloads it to the user's display device. Applicants, on the contrary, claim a plug-in that includes information about a preference of the user. Nowhere does Holtz disclose a plug-in. Nowhere does Holtz disclose a plug-in that includes information about the preference of the user.

Since Holtz does not anticipate each and every element of Applicants' dependent amended claims 26-28, either expressly or inherently, Applicants' dependent claims 26-28 are

not anticipated by Holtz, and a rejection under 35 U.S.C. § 102(e) is inappropriate. Applicants assert that dependent amended claims 26-28 are now in condition for allowance. Applicants respectfully request the withdrawal of rejections under 35 U.S.C. § 102(e) with regards to dependent amended claims 26-28 for the reasons set forth above. Furthermore, a 35 U.S.C. § 103 rejection of this claims would be inappropriate as well. Applicants' claimed invention is not an obvious extension of the use of Holtz to meet Applicants' patentable limitations.

Applicants have amended independent claim 29 to clarify the invention as follows:

Claim 29: (currently amended) A method of utilizing executable code in a transmitter for providing an advertisement to a client device, said method comprising the steps of:

receiving the advertisement from a service provider about a service offered by said the service provider;

formatting the advertisement for transmission to the client device operating within a coverage area of the transmitter; and

conveying the advertisement from the transmitter to the client device over a communication medium.

Applicants respectfully request Examiner to reconsider the rejection of claim 29 in light of Applicants' amendments and the following arguments. To further Applicants' position of the patentability of amended claim 29 (and amended claims 30-34 that depend, either directly or indirectly, from amended claim 29), Applicants note the following.

With respect to amended independent claim 29, on page 5 of the Office Action,

(1) Examiner states that Holtz teaches a method of utilizing executable code in a transmitter for providing an advertisement to a client device operating within a coverage area associated with said transmitter, said method comprising the steps of receiving said advertisement from a service offered by said service provider (see col. 11, lines 57-66, Holtz discloses receiving advertising link);

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses a customized media production in which advertisements are linked to each segment of each customized program so that the user, when viewing the customized programming, also views the linked advertising. Applicants, on the contrary, claim a method for utilizing executable code in a transmitter for providing an advertisement to a client device in which the method comprises the step of receiving the advertisement from a service provider about a service offered by the service provider. Nowhere does Holtz disclose utilizing executable code in a transmitter that receives an advertisement from a service provider about a service offered by the service provider.

(2) Examiner states that Holtz teaches the step of formatting said advertisement for transmission to said client device (see col. 8, lines 13-22, Holtz discloses the transmission of formatted media stream);

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses an enhanced media server that transmits, to enhanced media clients, media streams formatted to support multimedia applications. Applicants, on the contrary, claim the step of formatting the advertisement for transmission to a client device operating within a context associated with the transmitter. Nowhere does Holtz disclose transmitting an advertisement to a client device operating within a context associated with a transmitter. Nowhere does Holtz disclose a transmitter that formats an advertisement.

(3) Examiner states that Holtz teaches the step of conveying said advertisement from said transmitter to said client device over a communication medium (see col. 3, line 62 – col. 4, line 18, Holtz discloses displaying media production on client device).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses advertisements that are enhancements that are linked to each segment of each standard or customized program so that the user viewing the transmission also views the linked advertising. Nowhere does Holtz disclose executable code in the transmitter that receives the

advertisements from the service provider and that performs the step of conveying the advertisement from the transmitter to the client device over a communication medium.

Since Holtz does not anticipate each and every element of Applicants' amended claim 29, either expressly or inherently, Applicants' amended claim 29 (as well as amended claims 30-34 that depend, either directly or indirectly, therefrom and that further define the invention) is not made obvious by Holtz, and a rejection under 35 U.S.C. § 102(e) is inappropriate. Applicants assert that amended claim 29 (as well as amended claims 30-34 that depend, either directly or indirectly, therefrom) is now in condition for allowance. Applicants respectfully request the withdrawal of rejections under 35 U.S.C. § 102(e) with regards to amended claim 29, and amended claims 30-34 which depend, either directly or indirectly, therefrom, for the reasons set forth above. Furthermore, a 35 U.S.C. § 103 rejection of these claims would be inappropriate as well. Applicants' claimed invention is not an obvious extension of the use of Holtz to meet Applicants' patentable limitations.

On page 6 of the Office Action, with respect to dependent amended claim 30, which depends from amended claim 29, Examiner states that Holtz teaches the method of claim 29 wherein said advertisement is comprised of an XML element (see col. 8, lines 13-22, Holtz discloses the transmission of formatted media stream to support multimedia application).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses an enhanced media server that transmits, to enhanced media clients, media streams formatted to support multimedia applications. Applicants, on the contrary, claim that the advertisement is comprised of an XML element, where the advertisement is formatted by executable code in a transmitter. Nowhere does Holtz disclose conveying an advertisement in XML format from a transmitter to a client device that is operating within the coverage area associated with the transmitter.

On page 6 of the Office Action, with respect to dependent amended claim 31, which depends from amended claim 30,

(1) Examiner states that Holtz teaches the method of claim 30 wherein said advertisement further comprises service information enabling a user of said client device to make a decision about said service provider, said decision being based on said service information (see col. 35, line 45 – col. 36, line 50, Holtz discloses various pricing models to choose from);

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses a sales manager that is programmed to implement a pricing model for advertisements that accompany the personalized media production of Holtz. Holtz discloses that advertisers wishing to purchase commercial time have a choice of options. Applicants, on the contrary, claim an advertisement that includes service information enabling the user of the client device to make a decision about the service, the decision being based on the service information. The user of the client device, in the system of Holtz, is the online user, not the provider of a service wishing to provide an advertisement to the client device or online user.

(2) Examiner states that Holtz teaches the method of claim 30 wherein said advertisement further comprises data entry information informing said user about utilizing a service associated with said service provider (see col. 35, line 64 – col. 36, line 7, Holtz discloses price information of advertisement;

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses a system that provides the prices that commercial entities pay for advertisements that accompany the personalized media production that is provided to an online client. Applicants, on the contrary, claim an advertisement that includes data entry information informing the user about utilizing the service. Nowhere does Holtz disclose what the advertisement includes.

(3) Examiner states that Holtz teaches the method of claim 30 wherein said advertisement further comprises contact information containing instructions for enabling said client device to communicate with said service provider (see col. 3, lines 46-52, Holtz discloses the interaction between the user and the client server).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses a system that transmits a media production over wired or wireless channels to one or

more clients (such as, a personal computer, personal digital assistant, etc.). An online user in the system of Holtz can operate the client to display and interact with the media production. The user can customize the program or request a standard program. Applicants, on the contrary, claim an advertisement that includes contact information containing instructions for enabling the client device to communicate with the service provider. Nowhere does Holtz disclose an advertisement that includes contact information containing instructions for enabling the client device to communicate with the service provider.

Since Holtz does not anticipate each and every element of Applicants' dependent amended claims 30 and 31, either expressly or inherently, Applicants' dependent amended claims 30 and 31 are not anticipated by Holtz, and a rejection under 35 U.S.C. § 102(e) is inappropriate. Applicants assert that dependent amended claims 30 and 31 are now in condition for allowance. Applicants respectfully request the withdrawal of rejections under 35 U.S.C. § 102(e) with regards to dependent amended claims 30 and 31 for the reasons set forth above. Furthermore, a 35 U.S.C. § 103 rejection of this claims would be inappropriate as well. Applicants' claimed invention is not an obvious extension of the use of Holtz to meet Applicants' patentable limitations.

With respect to amended claim 35, on pages 6-7 of the Office Action,

(1) Examiner states that Holtz teaches a method of utilizing executable code in a client device receiving an advertisement from a transmitter, said method comprising the steps of receiving said advertisement from an infrared communication signal conveyed from said transmitter and arriving at a communication interface associated with said client device, said advertisement containing at least a portion of a service offered by a service provider (see col. 11, lines 57-66, Holtz discloses receiving advertising link);

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses a customized media production in which advertisements are linked to each segment of each customized program so that the user, when viewing the customized programming, also views the linked advertising. Applicants, on the contrary, claim the step of receiving the advertisement from an infrared communication signal conveyed from the transmitter and arriving



at a communication interface associated with the client device, where the advertisement contains at least a portion of a service offered by a service provider.

(2) Examiner states that Holtz teaches the step of decoding said advertisement to extract information contained therein (see col. 3, line 62 – col. 4, line 34, Holtz discloses displaying of advertisement by different criteria);

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses advertisements that are enhancements that are linked to each segment of each standard or customized program so that the user viewing the transmission also views the linked advertising. Nowhere does Holtz disclose decoding the advertisement to extract information contained therein.

(3) Examiner states that Holtz teaches the step of processing said information (see col. 9, lines 55-62, Holtz discloses the processing of the request);

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses an enhanced media server that functions as a portal to process or service requests for media produced or archived within system 100, and enforces security protocols to protect system data. Applicants, on the contrary, claim the step of processing the information extracted from the advertisement.

(4) Examiner states that Holtz teaches the step of displaying said information to a user of said client device (see col. 3, line 62 – col. 4, line 18, Holtz discloses displaying media production on client device).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses the production and distribution of various types of media products and value added enhancements. Holtz defines what media product and value added enhancements include, and that enhancements, including advertisements, can be linked to the media product so that the user, when viewing the transmission, also views the linked advertisement. Applicants, on the

contrary, claim the step of displaying information that includes at least a portion of a service offered by a service provider.

Since Holtz does not anticipate each and every element of Applicants' amended claim 35, either expressly or inherently, Applicants' amended claim 35 (as well as amended claims 36-42 that depend, either directly or indirectly, therefrom and that further define the invention) is not made obvious by Holtz, and a rejection under 35 U.S.C. § 102(e) is inappropriate. Applicants assert that amended claim 35 (as well as amended claims 36-42 that depend, either directly or indirectly, therefrom) is now in condition for allowance. Applicants respectfully request the withdrawal of rejections under 35 U.S.C. § 102(e) with regards to amended claim 35, and amended claims 36-42 which depend, either directly or indirectly, therefrom, for the reasons set forth above. Furthermore, a 35 U.S.C. § 103 rejection of these claims would be inappropriate as well. Applicants' claimed invention is not an obvious extension of the use of Holtz to meet Applicants' patentable limitations.

On page 7 of the Office Action, with respect to dependent amended claim 36, which depends from amended claim 35, Examiner states that Holtz teaches the method of claim 35 wherein said advertisement is comprised of an XML element (see col. 8, lines 13-22, Holtz discloses the transmission of formatted media stream to support multimedia application).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses an enhanced media server that transmits, to enhanced media clients, media streams formatted to support multimedia applications. Applicants, on the contrary, claim that the advertisement is comprised of an XML element, where the advertisement is processed by executable code in the client device. Nowhere does Holtz disclose utilizing executable code in a client device to receive an advertisement in XML format from an infrared communication signal conveyed from a transmitter into a client device.

On page 5 of the Office Action, with respect to dependent amended claim 37, which depends from amended claim 36,

(1) Examiner states that Holtz teaches the method of claim 36 wherein said advertisement further comprises service information enabling said user to make a decision about said service, said decision based on said service information (see col. 35, line 45 – col. 36, line 50, Holtz discloses various pricing models to choose from);

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses a sales manager that is programmed to implement a pricing model for advertisements that accompany the personalized media production of Holtz. Holtz discloses that advertisers wishing to purchase commercial time have a choice of options. Applicants, on the contrary, claim an advertisement that includes service information enabling the user of the client device to make a decision about the service, the decision being based on the service information. The user of the client device, in the system of Holtz, is the online user, not the provider of a service wishing to provide an advertisement to the client device or online user.

(2) Examiner states that Holtz teaches the method of claim 36 wherein said advertisement further comprises data entry information informing said user about utilizing said service (see col. 35, line 64 – col. 36, line 7, Holtz discloses price information of advertisement); and

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses a system that provides the prices that commercial entities pay for advertisements that accompany the personalized media production that is provided to an online client. Applicants, on the contrary, claim an advertisement that includes data entry information informing the user about utilizing the service. Nowhere does Holtz disclose what the advertisement includes.

(3) Examiner states that Holtz teaches the method of claim 36 wherein said advertisement further comprises contact information containing instructions enabling said client device to communicate with said service provider (see col. 3, line 46-52, Holtz discloses the interaction between the user and the client server).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses a system that transmits a media production over wired or wireless channels to one or more clients (such as, a personal computer, personal digital assistant, etc.). An online user in the

system of Holtz can operate the client to display and interact with the media production. The user can customize the program or request a standard program. Applicants, on the contrary, claim an advertisement that includes contact information containing instructions for enabling the client device to communicate with the service provider. Nowhere does Holtz disclose an advertisement that includes contact information containing instructions for enabling the client device to communicate with the service provider.

On page 7 of the Office Action, with respect to dependent amended claim 38, which depends from amended claim 37, Examiner states that Holtz teaches the method of claim 37 wherein said transmitter includes an emitter link layer (see col. 8, lines 13-22).

On page 7 of the Office Action, with respect to dependent amended claim 39, which depends from amended claim 38, Examiner states that Holtz teaches the method of claim 38 wherein said client includes a client device link layer (see col. 8, lines 13-22).

On pages 7-8 of the Office Action, with respect to dependent amended claim 40, which depends from amended claim 39, Examiner states that Holtz teaches the method of claim 39 wherein said emitter link layer is compatible with said client device link layer (see col. 8, lines 13-22).

As a rebuttal to Examiner's position for amended claims 38-40, Applicants respectfully point out that Holtz discloses an enhanced media server that transmits, to enhanced media clients, media streams formatted to support multimedia applications. Applicants, on the contrary, claim a transmitter that includes an emitter link layer. Nowhere does Holtz disclose a transmitter that includes an emitter link layer. Further, Applicants claim a client that includes a client device link layer. Nowhere does Holtz disclose a client that includes a client device link layer. Finally, Applicants claim that the emitter link layer is compatible with the device link layer. Nowhere does Holtz disclose an emitter link layer that is compatible with a device link layer.

On page 8 of the Office Action, with respect to dependent amended claim 41, which depends from amended claim 40, Examiner states that Holtz teaches the method of claim 40

wherein said information about said service is displayed to said user if said client device is running a plug-in cooperatively associated with said service (see col. 4, lines 35-42, Holtz discloses displaying advertised item).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses that pricing models are based on a combination of over-the-air broadcast criteria and client-server metrics, and that these factors are combined to create varying degrees of certainty that a sponsored advertisement actually would be presented, received or viewed by the greatest quantity of users most likely to purchase the advertised item or service. Applicants, on the contrary, claim that the information about the service is displayed to the user if the client device is running a plug-in cooperatively associated with the service. Nowhere does Holtz disclose that the information about the service is displayed to the user if the client device is running a plug-in cooperatively associated with the service.

On page 8 of the Office Action, with respect to dependent amended claim 42, which depends from amended claim 41, Examiner states that Holtz teaches the method of claim 41 wherein said plug-in further comprises information about a preference of said user (see col. 4, line 58 – col. 5, line 7, Holtz discloses setting up of a template based on personal preference).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses integration of media productions from various sources, and that a live media production is recorded at a local station and is indexed for easy retrieval and viewing by viewers who can either query the index and select the news segment they want to view or the user can set up a template to automatically generate a news program based on personal preference. The system of Holtz then compiles the news program, potentially with advertisements, and downloads it to the user's display device. Applicants, on the contrary, claim executable code in a client device that includes a plug-in where the plug-in includes information about a preference of the user. Nowhere does Holtz disclose a plug-in. Nowhere does Holtz disclose a plug-in that includes information about the preference of the user.

Since Holtz does not anticipate each and every element of Applicants' dependent amended claims 36-42, either expressly or inherently, Applicants' dependent amended claims 36-

42 are not anticipated by Holtz, and a rejection under 35 U.S.C. § 102(e) is inappropriate. Applicants assert that dependent amended claims 36-42 are now in condition for allowance. Applicants respectfully request the withdrawal of rejections under 35 U.S.C. § 102(e) with regards to dependent amended claims 36-42 for the reasons set forth above. Furthermore, a 35 U.S.C. § 103 rejection of this claims would be inappropriate as well. Applicants' claimed invention is not an obvious extension of the use of Holtz to meet Applicants' patentable limitations.

***Claim Rejections - 35 USC § 103***

On pages 8-12 of the Office Action, Examiner has rejected claims 2-13, 20, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Holtz.

Applicants have cancelled claim 2 without prejudice. Applicants assert that, since dependent amended claims 3-13 depend upon allowable amended claim 1, as argued above, they are therefore allowable. To further Applicants' position of the patentability of dependent amended claims 3-13, Applicants note the following.

On page 9 of the Office Action, with respect to dependent amended claim 3, Examiner states that Holtz teaches the method of claim 2 further comprising the step of selecting said service based on said advertising information (see col. 36, lines 51-67, Holtz discloses the usage of advertising administration system).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses a sales manager that can be configured to search and compile rate cards per newscast, ratings updates, etc., as well as open advertising slots and take advertisement orders. Applicants, on the contrary, claim a method for distributing an advertisement for a service at a location to a client device at the location that includes the step of selecting the service based on the advertising information that includes an XML element having service information, data entry information, and contact information. Whereas Holtz discloses a method for a service provider to purchase advertising time, Applicants disclose a method whereby a user can select a service

based upon the advertisement. Nowhere does Holtz claim the step of selecting the service based on the advertising information.

On page 9 of the Office Action, with respect to dependent amended claim 4, Examiner states that Holtz teaches the method of claim 3 further comprising the step of constructing a user interface for allowing said user to communicate with said client device (see col. 15, lines 20-35 and Fig. 3, Holtz discloses communication interface between computer system and external device).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses communications interface 324 that allows software and data to be transferred between computer system 300 and external devices. Holtz also discloses, in FIG. 3, communications interface 324 connecting communication infrastructure 306 and communications path 326. Applicants, on the contrary, claim the step of constructing a user interface for allowing the user to communicate with the client device. Nowhere does Holtz disclose the step of constructing a user interface for allowing the user to communication with the client device.

On pages 9-10 of the Office Action, with respect to dependent amended claim 5, Examiner states that Holtz teaches the method of claim 4 further comprising the step of receiving user inputs communicatively associated with said advertising information (see col. 16, lines 34-42, Holtz discloses the acknowledgement receipt of the user's specifications).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses an enhanced media service that acknowledges the receipt of all the necessary specifications. Holtz discloses that advertisements are provided to the user preceding the start of the customized program, and, during this time, the enhanced media server searches for segments from each of the hosting media facilities that are geographically appropriate according to the parameters provided by the user. Applicants, on the contrary, claim the step of receiving user inputs communicatively associated with the advertising information. Whereas Holtz discloses the selection of advertisements that are appropriate according to geographic parameters supplied by the user, Applicants claim selecting a service based on advertising information, and receiving user inputs in response to the advertising information. In the former case, which advertisements

are provided to the user can be based on pre-defined parameters that could be supplied by a user, a service provider, or by default. In the latter case, advertisements are provided to a user and the user selects and is able to purchase a location-dependent service based on the advertisement.

On page 10 of the Office Action, with respect to dependent amended claim 6, Examiner states that Holtz teaches the method of claim 5 further comprising the step of formatting said user inputs and a portion of said advertising information into a user reply, said user reply for making said user inputs available to said service (see col. 16, lines 49-53, Holtz discloses the assembling of order segment according to customized specifications).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses an enhanced media server that assembles the segments and orders them according to the program specifications. After the advertisements complete, the user begins receiving the customized program, with advertisements interspersed with the program segments. Applicants, on the contrary, claim the step of formatting user inputs and a portion of the advertising information into a user reply, where the user reply is used for making the user inputs available to the service. Whereas Holtz discloses merging and distributing customized media programming with purchased commercials, Applicants claim formatting a user reply that is based on user inputs to a formatted advertisement for a service.

On page 10 of the Office Action, with respect to dependent amended claim 7, Examiner states that Holtz teaches the method of claim 6 wherein said user reply is received at said transmitter (see col. 16, lines 34-53, Holtz discloses the reception of the reply and the user reception of the customized program).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses an enhanced media server that acknowledges receipt to the user of all the necessary specifications and provides the user with advertisements before the customized media program starts. While the advertisements are playing, the enhanced media server searches for segments that the user has chosen from a geographically appropriate hosting media facility according to the user's parameters, and plays the segments at the time and in the order that the user has specified. Applicants, on the contrary, claim the steps of selecting a service based on an



advertisement, constructing a user interface to allow the user to communicate with the client device, receiving user inputs in response to the advertisement, formatting the user inputs and a portion of the advertisement into a user reply and making that reply available to the service, and receiving the user reply at the transmitter. Whereas Holtz discloses the sequence of events through which a media production and advertisement are provided to a user according to user-specified parameters, Applicants claim a user's creating a reply to an advertisement and making the reply available to the service through a transmitter.

On page 10 of the Office Action, with respect to dependent amended claim 8, Examiner states that Holtz teaches the method of claim 7 wherein said user reply is received as a wireless signal from said client device (see col. 7, lines 48-65, Holtz discloses wireless transmission media).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses an enhanced media server and enhance media client. The server in the system of Holtz provides web pages for a hosting portal, homepage, or web site. Holtz discloses a communication infrastructure that includes wired or wireless local or wide area networks and wired or wireless transmission media. Applicants, on the contrary, claim that the user reply is received at the transmitter as a wireless signal from the client device. The system of Holtz includes a server and a client whereas the system of Applicants includes a service provider, a transmitter, and a client device. Applicants' claim implies a wireless communication route between the client device and the transmitter. Nowhere does Holtz distinguish, as Applicants have done, between a transmitter and a service provider.

On page 10 of the Office Action, with respect to dependent amended claim 9, Examiner states that Holtz teaches the method of claim 7 wherein said user reply is received at said transmitter using a communication interface providing electromechanical contact between said client device and said transmitter (see col. 14, lines 57-60 and Fig. 3, Holtz discloses the interface and communication infrastructure).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses a computer system 300 that includes a display interface that forwards graphics, text,

and other data from the communication infrastructure 306 for display on display unit 330. Applicants, on the contrary, claim that the user reply is received at the transmitter using a communication interface providing electromechanical contact between the client device and the transmitter. Whereas Holtz discloses communication between a display interface, a communication infrastructure, and a display unit, Applicants claim electromechanical contact between the client device and the transmitter through which the user reply travels.

On pages 10-11 of the Office Action, with respect to dependent amended claim 10, Examiner states that Holtz teaches the method of claim 9 further comprising the step of receiving a service response from said transmitter, said service response including at least one member selected from the group consisting of a graphical representation of said service for display on said client device, executable code for allowing said client device to interact with said service, and text for display on said client device (see col. 3, line 62 – col. 4, line 18, Holtz discloses the graphical or text presentation of the interaction).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses the product and distribution of various types of media productions and enhancements. Holtz provides definitions of media productions and enhancements that, Holtz discloses, can be linked to the media production. Holtz discloses that, when the media production is viewed, the enhancement is also viewed. Applicants, on the contrary, claim the step of receiving a service response from the transmitter, wherein the service response can be a graphical representation of the service for display on the client device, executable code for allowing the client device to interact with the service, and text for display on the client device. Whereas Holtz discloses that media products and enhancements are viewed together, Applicants claim receiving a service response from a transmitter, where the service response can be a graphical representation, executable code or text for display. Nowhere does Holtz disclose receiving a service response from a transmitter.

On page 11 of the Office Action, with respect to dependent amended claim 11, Examiner states that Holtz teaches the method of claim 6 wherein said user reply is received at a point-of-

presence (POP) (see col. 45, line 58 – col. 46, line 9 and Fig. 2, Holtz discloses information server provider for promotion and advertisement).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses ways in which advertising spots are sold, and a master database for identifying available spots, scheduling national advertising spots, archiving national advertising spots, serving national advertising, and managing local advertisements. Applicants, on the contrary, claim that the user reply to the service advertisement is received at a POP. Whereas Holtz discloses the sale of advertising space, Applicants provide a path for the user to reply to the advertisement at a POP.

On page 11 of the Office Action, with respect to dependent amended claim 12, Examiner states that Holtz teaches the method of claim 11 wherein said user reply is received over a personal digital assistant (PDA) interface providing electromechanical contact between said client device and said POP (see col. 7, line 66 – col. 8, line 12, Holtz discloses wireless exchanges over communication infrastructure).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses that the enhanced media client is, among other things, a PDA that is operable for wired or wireless transmission over the communication infrastructure 110. Holtz discloses that a user can request a web page from enhanced media service 115 over the Internet or the like. Applicants, on the contrary, claim a PDA interface that provides electromechanical contact between the client device and the POP. Nowhere does Holtz disclose an electromechanical contact between a client device and a POP.

On page 11 of the Office Action, with respect to dependent amended claim 13, Examiner states that Holtz teaches the method of claim 12 further comprising the step of receiving a service response from said POP, said service response including at least one member selected from the group consisting of a graphical representation of said service for display on said client device, executable code for allowing said client device to interact with said service, and text for display on said client device (see col. 3, line 62 – col. 4, line 18, Holtz discloses the graphical or text presentation of the interaction).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses the production and distribution of various types of media productions and enhancements. Holtz provides definitions of media productions and enhancements that, Holtz discloses, can be linked to the media production. Holtz discloses that, when the media production is viewed, the enhancement is also viewed. Applicants, on the contrary, claim the step of receiving a service response from the POP, wherein the service response can be executable code for allowing the client device to interact with the service. Whereas Holtz discloses that media products and enhancements are viewed together, Applicants claim receiving a service response from a POP. Nowhere does Holtz disclose receiving a service response from a POP. Nowhere does Holtz disclose receiving a service response that is executable code for allowing the client device to interact with the service.

On pages 11-12 of the Office Action, with respect to dependent amended claim 20,

(1) Examiner states that Holtz teaches a method for conveying an advertisement from a transmitter having a link layer, said method comprising the steps of receiving said advertisement from a service (see col. 11, lines 57-66, Holtz discloses receiving advertising link);

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses a customized media production in which advertisements are linked to each segment of each customized program so that the user, when viewing the customized programming, also views the linked advertising. Applicants, on the contrary, claim the step of receiving the advertisement from a service into a transmitter having a link layer. A link layer is executable code that manages communications at the link level between the transmitter and the client device. Nowhere does Holtz disclose a transmitter having a link layer. Nowhere does Holtz disclose a transmitter that receives an advertisement from a service.

(2) Examiner states that Holtz teaches the step of formatting said advertisement for transmission to a client device operating within a context associated with said transmitter (see col. 8, lines 13-22, Holtz discloses the transmission of formatted media stream);

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses an enhanced media server that transmits, to enhanced media clients, media streams formatted to support multimedia applications. Applicants, on the contrary, claim the step of formatting the advertisement for transmission to a client device operating within a context associated with the transmitter. Nowhere does Holtz disclose transmitting an advertisement to a client device operating within a context associated with a transmitter. Nowhere does Holtz disclose a transmitter that formats an advertisement.

(3) Examiner states that Holtz teaches the step of conveying said advertisement to said client device over a communication medium (see col. 3, line 62 – col. 4, line 18, Holtz discloses displaying media production on client device).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses the production and distribution of various types of media products and value added enhancements. Holtz defines what media product and value added enhancements include, and that enhancements, including advertisements, can be linked to the media product so that the user, when viewing the transmission, also views the linked advertisement. Applicants, on the contrary, claim the step of conveying the advertisement to the client device over a communication medium.

(4) Examiner states that Holtz does not teach XML. Examiner states that Official Notice is taken as evident by Microsoft computer Dictionary 5<sup>th</sup> edition that it would have been obvious to use XML because doing so would offer greater flexibility in organizing and processing information.

Applicants respectfully rebut the Official Notice taken that Applicants' utilization of XML to format the advertisement for transmission to a client device operating within a context associated with a transmitter would have been obvious to one having ordinary skill in the art at the time the invention was made. Although XML is in common use, the use of XML to format advertisements for transmission to a client device operating within a context associated with the transmitter is not in common enough use so that a reference to its use can be found by a simple

search of the internet. Further, Applicants' use of XML to format advertisements in combination with Applicants' other claimed features is not an obvious extension of Holtz. Finally, it is impermissible hindsight reconstruction to find the motivation to use XML to format a location-dependent advertisement in the combination of Holtz and the Microsoft Dictionary 5<sup>th</sup> edition, neither of which discloses or suggests the formatting of an advertisement for transmission to a client device operating within a context associated with a transmitter.

In order for a rejection under 35 U.S.C. § 103 to be sustained, the Examiner must establish a *prima facie* case of obviousness. As pointed out in MPEP § 2142, one of the three criteria to establish a *prima facie* case of obviousness is that the prior art reference(s) must teach or suggest all the claim limitations. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Further, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Applicants assert that there is no suggestion or motivation in either Holtz or Official Notice to perform the claimed subject matter of amended claims 3-13 and 20. Since Holtz and Official Notice, separately or in combination, do not teach or suggest each and every element of Applicants' dependent amended claims 3-13 and 20, which depend upon amended claims 1 and 19, either expressly or inherently, Applicants' dependent amended claims 3-13 and 20 are not made obvious by Holtz and Official Notice, and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants assert that dependent amended claims 3-13 and 20 are now in condition for allowance. Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 103(a) with regards to dependent amended claims 3-13 and 20 for the reasons set forth above.

On page 12 of the Office Action, with respect to dependent claim 21, Applicants have cancelled dependent claim 21 without prejudice.

On pages 13-14 of the Office Action, Examiner has rejected claims 22, 23, and 32-34 under 35 U.S.C. § 103(a) as being unpatentable over Holtz and further in view of Freitas et al., U.S. Patent No. 5,321,542, issued on June 14, 1994 (Freitas).

On page 13 of the Office Action, with respect to dependent amended claims 22 and 32, which depend, directly or indirectly, from independent amended claims 19 and 29 respectively,

(1) Examiner states that Holtz teaches a method for conveying an advertisement from a transmitter having a link layer, said method comprising the step of receiving said advertisement from a service (see col. 11, line 57-66, Holtz discloses receiving advertising link);

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses a customized media production in which advertisements are linked to each segment of each customized program so that the user, when viewing the customized programming, also views the linked advertising. Applicants, on the contrary, claim the step of either receiving the advertisement from a service into a transmitter having a link layer, or utilizing executable code in a transmitter for receiving the advertisement from a service provider, where the advertisement is for a service offered by the service provider. In the first case, a link layer is executable code that manages communications at the link level between the transmitter and the client device. Nowhere does Holtz disclose a link layer. In the second case, whereas Holtz discloses linking advertisements to media products, Applicants claim utilizing executable code in a transmitter to receive a particular type of advertisement (an advertisement for a service) from a particular source (a service provider).

(2) Examiner states that Holtz teaches the step of formatting said advertisement from transmission to a client device operating within a context associated with said transmitter (see col. 8, line 13-22, Holtz discloses the transmission of formatted media stream);

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses an enhanced media server that transmits, to enhanced media clients, media streams formatted to support multimedia applications. Applicants, on the contrary, claim the step of formatting the advertisement for transmission to a client device operating within a context or coverage area of the transmitter. Nowhere does Holtz disclose transmitting an advertisement to a client device operating within a context or coverage area of a transmitter. Nowhere does Holtz disclose a transmitter having a link layer that formats an advertisement.

(3) Examiner states that Holtz teaches the step of conveying said advertisement to said client device over a communication medium (see col. 3, line 62 – col. 4, line 18, Holtz discloses displaying media production on client device).

As a rebuttal to Examiner's position, Applicants respectfully point out that Holtz discloses the production and distribution of various types of media products and value added enhancements. Holtz defines what media product and value added enhancements include, and that enhancements, including advertisements, can be linked to the media product so that the user, when viewing the transmission, also views the linked advertisement. Applicants, on the contrary, claim the step of either conveying the advertisement from a transmitter having a link layer to the client device over a communication medium, or utilizing executable code in the transmitter to convey the advertisement to the client device over a communication medium. Nowhere does Holtz disclose a transmitter having a link layer. Nowhere does Holtz disclose executable code that is specifically in the transmitter, which is never specifically mentioned in Holtz.

(4) Examiner states that Holtz does not explicitly teach the limitation "transmitter as a diffuse infrared signal".

(5) Examiner states that Freitas teaches transmitter as a diffuse infrared signal (see col. 4, line 7-24, Freitas discloses infrared signal).

As a rebuttal to Examiner's position, Freitas discloses communications channels that are carried via an infrared (IR) data link having a preferred wavelength of approximately 1.4



microns, although a range of 750 nm to approximately 1000 nm is possible. Freitas discloses a command channel that permits a mobile unit to establish communication with the base station and also possibly through a network to a host system, before reliable data communication is possible, in order to effect an IR data communications network. Applicants, on the contrary, claim that the advertisement, which has particular contents as stated above, is conveyed from a transmitter as a diffuse IR signal. Neither Freitas nor Holtz disclose an advertisement having particular contents being conveyed from a transmitter as a diffuse IR signal.

(5) Examiner states that it would have been obvious to use infrared in Holtz invention as taught by Freitas because doing so would allow the user to send and receive files using wireless communication.

As stated above, in order for a rejection under 35 U.S.C. §103 to be sustained, the Examiner must establish a *prima facie* case of obviousness and to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference, and the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination must be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicants assert that there is no suggestion or motivation in either Holtz or Freitas to conveying advertisements having particular content as a diffuse IR signal. Since Holtz and Freitas, separately or in combination, do not teach or suggest each and every element of Applicants' dependent amended claims 22 and 32, which depend upon amended claims 19 and 29, either expressly or inherently, Applicants' dependent amended claims 22 and 32 are not made obvious by Holtz and Freitas, and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants assert that dependent amended claims 22 and 32 are now in condition for allowance. Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 103(a) with regards to dependent amended claims 22 and 32 for the reasons set forth above.

On page 13 of the Office Action, with respect to dependent amended claims 23 and 33, Examiner states that Freitas teaches signal has a wavelength in the range of substantially 850

nanometers to 1250 nanometers (col. 7-24, Freitas discloses operation within approximately 750-1000 nanometers).

Applicants interpret Examiner's reference to be col. 4, lines 7-24. As a rebuttal to Examiner's position, Applicants respectfully point out that neither Freitas nor Holtz disclose an advertisement having particular contents being conveyed from a transmitter as a diffuse IR signal in the range of 850 nm to 1250 nm.

Since Holtz and Freitas, separately or in combination, do not teach or suggest each and every element of Applicants' dependent amended claims 23 and 33 (and dependent amended claim 34 which depends therefrom), which depend upon amended independent amended claims 19 and 29, either expressly or inherently, Applicants' dependent amended claims 23 and 33 (and dependent amended claim 34 which depends therefrom) are not made obvious by Holtz and Freitas, and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants assert that dependent amended claims 23 and 33 (and dependent amended claim 34 which depends therefrom) are now in condition for allowance. Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 103(a) with regards to dependent amended claims 23 and 33 (and dependent amended claim 34 which depends therefrom) for the reasons set forth above.

On page 14 of the Office Action, with respect to dependent amended claim 34, Examiner states that Freitas teaches infrared signal is generated by modulating an electric light (see col. 11, lines 7-24).

As a rebuttal to Examiner's position, Applicants respectfully point out that Freitas discloses that when a data channel is inoperable, a diffuse transmission channel can be used, although the transmission rate may be slower. Freitas also discloses conveying command and data traffic by a low speed diffuse channel. Applicants, on the contrary, claim that the diffuse IR signal that carries an advertisement having particular contents is generated by modulating an electric light. Nowhere does Freitas disclose generating a diffuse IR signal by modulating an electric light.

Since Freitas does not teach or suggest each and every element of Applicants' dependent amended claim 34, which depends indirectly upon amended independent amended claim 29, either expressly or inherently, Applicants' dependent amended claim 34 is not made obvious by Freitas/Holtz, and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants assert that dependent amended claim 34 is now in condition for allowance. Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 103(a) with regards to dependent amended claim 34 for the reasons set forth above.

### ***Conclusion***

Amended claims 1, 3-20, and 22-42 and new claims 43-45 are believed to be in condition for allowance. All dependent claims are believed to depend upon allowable independent claims, and are therefore also in condition for allowance.

Applicants further respectfully point out that Examiner's cited reference, Holtz, was published on May 2, 2002, almost a year after the filing date of the present application, August 15, 2001. Holtz was filed on April 18, 2001, whereas Applicants' provisional patent application upon which the present application depends was filed on August 15, 2000. Applicants respectfully reserve the right to either predate Holtz or file a petition under 37 C.F.R. § 1.131 to swear behind Holtz.

The present amendment adds 3 new dependent claims, but has also deleted 2 dependent claims, and therefore the fee for a dependent claim (over 20) for a large entity, \$50, is included with this Amendment.

Additionally, Applicants enclose herewith an Information Disclosure Statement under 37 CFR 1.97(c)(2). The required fee of \$180.00 is enclosed herewith.

The Commissioner for Patents is authorized to charge additional fees which may be required or credit overpayment to Deposit Account No. 03-2410, Order No. 12078-142.


Appl. No. 09/929,995  
Amdt. Dated, February 23, 2004  
Reply to Office Action of November 23, 2004  
Docket No.: 12078-142

The following information is presented in the event that a call may be deemed desirable  
by the Examiner: JACOB N. ERLICH (617) 854-4000.

Respectfully submitted,  
Noah J. Ternullo et al., Applicants

Date: February 23, 2004

By:



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